

### REMARKS

In response to the Office Action of August 13, 2002 applicant respectfully requests reconsideration and allowance of the claims in their amended form.

By this amendment, Applicant has withdrawn claims 11, 14, 15 and 16 from the application and included the subject matter of claim 11 in claim 9. In effect the amendment to claim 9 merely indicates that a GPS receiver is employed to indicate the individual's present location.

Applicant is submitting this supplemental amendment for his amendment dated September 26, 2002 (which has not been entered) in order to correctly indicate in Claim 9 that the "GPS receiver" inadvertently inserted at line 4 of this claim, should properly have been inserted at line 6, since it is the GPS receiver which indicates the individual's present location. Any inconvenience to the Examiner is sincerely regretted.

It is, therefore, respectfully requested that the present amendment be entered and not the unentered amendment of September 26, 2002.

It is respectfully submitted that the present amendment does not raise any new issues and should not require a new search since claim 11 was present in the application as originally filed.

Before discussing the Rosen et al. references, applicant would like to emphasize that his invention as presently claimed is a proactive means for alerting an individual as to the availability of goods and/or services at locations to which the individual may travel to or through. The individual does not initially request such goods or services but is made aware of them through a network which offers to supply goods or services in the expectation that the individual might decide to accept such offer.

Hence it is not the individual traveler who is soliciting information regarding the availability of goods and services as he or she travels to different locations, but the offer to supply such goods or services is made by a network which knows where he or she is at a given moment, which knows the profile of such traveler and what his or her needs might be at such a location.

In contrast, the Rosen et al. reference is directed to the traveler who is the one seeking information regarding goods or services.

On lines 45-55 at column 1 of Rosen et al, it is stated under "Summary of the Invention" that a traveler can receive information "upon request." Also, "the user can control the level of detail of the information to match the user's needs and interest."

At several other places in the Rosen et al. patent, it is stated that it is the "user" or traveler who is himself or herself the one soliciting the information regarding goods or services. See for example, column 4, lines 64-66, "... a request for a particular facility ...; column 6, line 12-13; "... the user ... can select a resource ..." and the like.

In applicant's system if, for example, a particular motel on the traveler's route has a special discounted rate, this could be offered to the traveler unsolicited whereas in the Rosen et al. system the user could be unaware of such a discounted rate unless he or she makes a specific inquiry.

Applicant respectfully submits that an unsolicited offer made to an individual as to the availability of certain goods and/or services differs markedly from the same individual himself or herself who must take the initial step to inquire about the availability of such goods and/or services. If left to the individual to inquire many discounts, promotion schemes, and other time-related benefits might remain unknown if such inquiry is not timely made.

Applicant respectfully direct the Examiner's attention to his specification wherein at several places it is evident that the availability of goods and/or services originates not by an individual's inquiry, but by an unsolicited offer or invitation. For example, on pages 6 and 7 of the specification it is stated with respect to the objective of the invention:

"Briefly state, these objects are attained by a network adapted to target an individual operating a microcomputer that is microwave-linked to an Internet highway to offer this individual goods or services appropriate to his needs available at a place within range of the individual's present location. The microcomputer is provided with a GPS receiver that indicates the present location of the individual, this location and the identity of the individual being transmitted from the microcomputer to a web site on the highway.

At the web site, a computer associated with a data bank storing the profiles of a multitude of consumers is programmed to find out whether the identified individual is included in the data bank, and to determine from his profile whether there are available at a place reachable from his present location appropriate goods or services. If a match is found, an offer to supply such goods or services is conveyed from the web site to the microcomputer." (underlining added)

Also on page 10 of the specification it is stated:

"For example, if the profile indicates that the individual is a middle aged, well-to-do business man and his present location is in midtown New York City, then programmed computer 16 will transmit from web site 15 to microcomputer 10 an invitation to this individual to have lunch at a nearby restaurant at a substantial discount which will be given by presenting the restaurant with a code number. Or the offer may take the form of an invitation to purchase designer clothing at a discount at a nearby boutique." (underlining added)

It is submitted that unsolicited "offers" and "invitations" are not the same as an inquiry by an individual to find the availability of goods and/or services.

What is a unique feature about the present invention is that it uses profile information, along with a Geopositioning chip to make offers to a person, who is traveling, based on the fact that it is known where his home base is, what time of day it is and where he is presently located. This invention does not send information to John Doe at his home with a special offer. It uses John Doe (who lives in New York), locates him in Florida and makes a local offer to him based on his preferences.

The combination of the geopositioning chip, along with preference data is a unique a new form of proactive solicitation, where somebody is contacted and made an offer specifically where they are.

Applicant, therefore, respectfully submits that a prima facie case of obviousness has not been made under 35 U.S.C. 103(a) in light of the Rosen et al. reference. There is nothing in Rosen et al. which suggests or would even motivate one of ordinary skill to devise the invention as presently claimed.

Applicant therefore respectfully submits that a prima facie case of obviousness has not been made over the cited art. There is no "fair suggestion" of applicant's invention under 35 U.S.C. 103(a).

Applicant respectfully submits that one must not lose weight of the statutory provisions under which patents are granted to inventors to protect their discoveries. Section 102 of Title 35 indicates that the right of an inventor to a patent is a positive one; that is, the inventor shall be entitled to a patent, unless one or more of the subdivisions of the section are applicable. Moreover, Section 103, when read in light of the preceding section, must also be considered from the premise that an inventor shall be entitled to a patent, unless the subject matter as a whole would have been obvious

to one of ordinary skill in the art at the time the invention was made. Hence, the invention in question must be obvious from the reference to that person who has ordinary skill and who is unaware of and has no knowledge of applicants' discovery. In other words, applicant's invention must manifest itself, or stand out from the teachings of the references. It must not be hidden in the teachings of the references, only to be uncovered by one who is viewing the art with knowledge already gleaned from applicant's application.

While it is often possible to select from the prior art, elements which will approximate the invention shown in the application, the fact that such selection can be made does not necessarily preclude the presence of a patentable invention. The test to be given to determine whether an invention is obvious is the "fair suggestion" test. There must be a "fair suggestion" from the prior art as to what applicant has done. It is respectfully submitted, therefore, that when the claims under consideration are rejected as being unpatentable over the cited art, that the test to be employed is one of "fair suggestion." It is imperative that the "fair suggestion" test be employed in arriving at a decision. The basic reason for the "fair suggestion" test is based upon the fact that the Examiner has had an opportunity to consider and to digest applicant's disclosure, prior to searching the art. As such, it is relatively easy for the Examiner to unintentionally hold that the references teach the invention under consideration. It is only when the reference "fairly suggests" the claimed invention that the rejection is proper, and this "fair suggestion" test must be approached without having recourse to the disclosure of applicant's application. (In re Lunsford, 148 U.S.P.Q. 721).

It is respectfully submitted that the reference cited by the Examiner does not suggest features as recited in the claims. Accordingly, applicant's invention would not be "fairly suggested" by the cited art. Withdrawal of the rejection is therefore respectfully requested.

For each of the foregoing reasons applicant submits that the claims in their amended form are in condition for allowance. Early favorable action is therefore respectfully requested.

In the event that this amendment does not place the claims in condition for allowance it is respectfully requested that this present amendment and not the unentered amendment dated September 26, 2002, be the one entered for purposes of appeal.

In the event that there are minor issues that could be resolved by a telephone interview, the Examiner is invited to call the undersigned at her convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William R. Moran", written over a horizontal line.

William R. Moran

Reg. No. 19,555

**LIEBERMAN & NOWAK, LLP**

350 Fifth Avenue

New York, New York 10118

(212) 947-0500

Attorneys for Applicant

**Marked-Up Version of Claim 9**

9. (Amended) A network for targeting an individual operating a microcomputer in order to offer to supply said individual with appropriate goods or services available at a place within reach of the individual's present location, said network comprising:

5                    associated with the microcomputer to microwave-link the microcomputer to an Internet highway;

                    [means associated with the microcomputer] a GPS receiver to indicate the individual's present location;

                    means to convey over the microwave link from the microcomputer to a web site  
10                   on the Internet highway, the identification of the individual and the individual's present location, thereby providing his full address;

                    means at the website storing profiles of a multitude of individuals who are consumers of the goods or services to determine from the profile of individual whose address has been forwarded to the web site, which goods or services are appropriate to said individual  
15                   and are available at a place reachable from his present address; and

                    means to convey from the web site to the microcomputer an offer to supply said appropriate goods or services.